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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,919	09/20/2000	Venkatachari Dilip	CE1-002US	8530

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EXAMINER

SHIH, SALLY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,919

Applicant(s)

DILIP ET AL.

Examiner

Sally Shih

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 38-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 38-65 is/are rejected.
- 7) ☒ Claim(s) 1-29 and 48-64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2003 has been entered.

Status of Claims

2. Of the original claims 1-47, claims 48-65 have been added, 31-37 have been cancelled and claims 12-20, 22, 28, 42, 51, 56 and 59 have been amended. Therefore, claims 1-30 and 38-65 are under prosecution in this application.

Summary of this Office Action

3. Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC §101

4. Claims 1-29 and 48-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-29 and 48-64 only recite an abstract idea. The recited steps of merely transfer funds or assets does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an insurance policy over another.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computer-implemented". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention is used in transfer assets or funds among financial institutions (i.e., useful and tangible).

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Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Example:

A **computerized** method for selecting an insurance policy comprising the steps of:

- (a) retrieving information from a customer **database** and an insurance policy **database**;
- (b) scoring the insurance policy **by a processor** based upon the information from the customer and policy; and
- (c) iterating steps (1) and (2) with different policies until a best insurance policy is selected based on a score determined from step (b).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30, 38-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan et al. (United States Patent Number 6,598,028 B1).

Claims 1, 11, 38, 41, 42 and 47: Sullivan et al. discloses a computer-implemented method, corresponding computer program and apparatus comprising:

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initiating a withdrawal of assets from a first account at a first financial institution (col. 9, lines 7-30; figs. 2, 4 and associated text); and

initiating a deposit of the withdrawn assets to a second account at a second financial institution, wherein the first account and the second account have a common account holder (col. 9, lines 7-30; figs. 2, 4 and associated text).

Claims 2, 40 and 43: Sullivan et al. discloses a method as recited in claim 1, corresponding computer program and apparatus wherein initiating a withdrawal of assets includes generating a debit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claims 3, 39 and 44: Sullivan et al. discloses a method as recited in claim 1, corresponding computer program and apparatus wherein initiating a deposit of assets includes generating a credit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claims 4 and 45: Sullivan et al. discloses a method and corresponding apparatus as recited in claim 1 wherein the assets are withdrawn via a first payment network and the assets are deposited via a second payment network (figs. 3-4 and associated text).

Claim 5. Sullivan et al. discloses a method as recited in claim 1 wherein the withdrawal of assets and the deposit of assets are effectuated via an ACH network (col. 10, lines 53-62).

Claim 6. Sullivan et al. discloses a method as recited in claim 1 wherein the withdrawal of assets and the deposit of assets are effectuated via a debit network (col. 7, lines 63-67; fig. 4 and associated text).

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Claim 7. Sullivan et al. discloses a method as recited in claim 1 wherein the withdrawal of assets and the deposit of assets are effectuated via a wire transfer (col. 13, lines 16-23; fig. 5 and associated text).

Claim 8. Sullivan et al. discloses a method as recited in claim 1 wherein the withdrawal of assets and the deposit of assets are effectuated via an ACH processor (col. 10, lines 53-62).

Claims 9 and 46: Sullivan et al. discloses a method as recited in claim 1 and corresponding apparatus wherein the withdrawal of assets and the deposit of assets are effectuated via a third financial institution (fig. 2 and associated text; col. 7, lines 63-67; col. 8, lines 1-10).

Claim 10. Sullivan et al. discloses a method as recited in claim 1 wherein the first account and the second account are asset accounts (col. 7, lines 63-67; col. 8, lines 1-10).

Claims 12 and 21: Sullivan et al. discloses a computer-implemented method and corresponding computer program of transferring funds comprising:

implementing a first transaction comprising:

withdrawing funds from a first account at a first financial institution (col. 9, lines 7-30; figs. 2, 4 and associated text); and

depositing the withdrawn funds into a second account, wherein the first account and the second account have different account holders (col. 9, lines 7-30; figs. 2, 4 and associated text);

implementing a second transaction comprising:

withdrawing the deposited funds from the second account (col. 10, lines 63-67; col. 11, lines 1-3; figs. 2, 4 and associated text); and

depositing the withdrawn funds into a third account a second financial institution, wherein the second account and the third account have different account holders and wherein the first account and the third account have a common account holder (col. 10, lines 63-67; col. 11, lines 1-3; figs. 2, 4 and associated text);

depositing the withdrawn funds into a second account at a second financial institution, wherein the first account and the second account have a common account holder (fig. 2-4 and associated text; col. 11, lines 50-58).

Claim 13. Sullivan et al. discloses a method as recited in claim 12 wherein withdrawing funds from first account includes generating a debit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claim 14. Sullivan et al. discloses a method as recited in claim 12 wherein depositing funds into the third account includes generating a credit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claim 15. Sullivan et al. discloses a method as recited in claim 12 wherein the funds are withdrawn from the first account via a first payment network and the funds are deposited into the third account via a second payment network (figs. 3-4 and associated text).

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Claim 16. Sullivan et al. discloses a method as recited in claim 12 wherein withdrawing funds from the first account and depositing funds into the third account are effectuated via an ACH network (col. 10, lines 53-62).

Claim 17. Sullivan et al. discloses a method as recited in claim 12 wherein withdrawing funds from the first account and depositing funds into the third account are effectuated via a debit network (col. 7, lines 63-67; fig. 4 and associated text).

Claim 18. Sullivan et al. discloses a method as recited in claim 12 wherein withdrawing funds from the first account and depositing funds into the third account are effectuated via a wire transfer (col. 13, lines 16-23; fig. 5 and associated text).

Claim 19. Sullivan et al. discloses a method as recited in claim 12 wherein withdrawing funds from the first account and depositing funds into the third account are effectuated via a third financial institution (figs. 2-4 and associated text).

Claim 20. Sullivan et al. discloses a method as recited in claim 12 wherein the first account and the third account are asset accounts (col. 7, lines 63-68; col. 8; lines 1-14).

Claim 22. Sullivan et al. discloses a method and corresponding computer program comprising:

registering a plurality of financial accounts at with a financial management system(fig. 4 and associated text), wherein the registering of a plurality of accounts allows the transfer of funds between any pair of registered accounts (fig. 2 and associated text); and

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initiating a transfer of funds from a first registered account associated with a first financial institution to a second registered account associated with a second financial institution wherein a third party entity initiate the transfer of funds (fig. 2, 4 and associated text).

Claim 23. Sullivan et al. discloses a method as recited in claim 22 wherein initiating a transfer of funds includes:

initiating a withdrawal of assets from the first registered account (col. 9, lines 7-30; figs. 2, 4 and associated text); and

initiating a deposit of the withdrawn assets to the second registered account (col. 9, lines 7-30; figs. 2, 4 and associated text).

Claim 24. Sullivan et al. discloses a method as recited in claim 23 wherein initiating a withdrawal of assets includes generating a debit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claim 25. Sullivan et al. discloses a method as recited in claim 23 wherein initiating a deposit of the withdrawn assets includes generating a credit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claim 26. Sullivan et al. discloses a method as recited in claim 23 wherein the assets are withdrawn via a first payment network and the assets are deposited via a second payment network (figs. 3-4 and associated text).

Claim 27. Sullivan et al. discloses a method as recited in claim 22 wherein the transfer of funds is effectuated via a wire transfer (col. 13, lines 16-23; fig. 5 and associated text).

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Claim 28. Sullivan et al. discloses a method as recited in claim 22 wherein the third party entity is a third financial institution (fig. 2 and associated text; col. 7, lines 63-67; col. 8, lines 1-10).

Claim 29. Sullivan et al. discloses a method as recited in claim 22 wherein the first account and the second account are asset accounts (col. 7, lines 63-68; col. 8, lines 1-14).

Claim 48. Sullivan et al. discloses a method comprising:

initiating a transfer of funds from a first account at a first financial institution to a second account at a second financial institution (col. 9, lines 7-30; figs. 2, 4 and associated text), wherein the transfer of funds is performed using an Automated Clearing House network (col. 10, lines 53-62); and wherein the first account and the second account have a common account holder (col. 9, lines 7-30; figs. 2, 4 and associated text).

Claim 49. Sullivan et al. discloses a method as recited in claim 48 wherein the first account and the second account are asset accounts (col. 7, lines 63-67; col. 8, lines 1-10).

Claim 50. Sullivan et al. discloses a method as recited in claim 48 wherein the transfer of funds is effectuated using a debit instruction and a credit instruction (col. 7, lines 63-67; fig. 4 and associated text).

Claim 51. Sullivan et al. discloses a method comprising:

initiating a withdrawal of funds from a first account at a first financial institution, wherein an instruction for the withdrawal of funds is initiated by an entity other than the first financial institution (col. 9, lines 7-30; figs. 2, 4 and associated text); and

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initiating a deposit of the withdrawn funds to a second account at a second financial institution wherein an instruction for the deposit of the withdrawn funds is initiated by entity other than the second financial institution (col. 9, lines 7-30; figs. 2, 4 and associated text).

Claim 52. Sullivan et al. discloses a method as recited in claim 51 wherein the first account and the second account are asset accounts (col. 7, lines 63-68; col. 8; lines 1-14).

Claim 53. Sullivan et al. discloses the method as recited in claim 51 wherein the deposit of withdrawn funds utilizes an ATM network (fig. 2 and associated text).

Claim 54. Sullivan et al. discloses the method as recited in claim 1 wherein the second account is a new account being funded by assets from the first account (col. 11, lines 51-65; fig. 2 and associated text).

Claim 55. Sullivan et al. discloses the method as recited in claim 22 wherein the second registered account is a new account being funded by assets from the first registered account (col. 11, lines 51-65; fig. 2 and associated text).

Claim 56. Sullivan et al. discloses a method comprising:

opening a new account at a first financial institution (fig. 2 and associated text; col. 9, lines 18-25);

identifying a second account at a second financial institution (fig. 2 and associated text; col. 7, lines 63-67; col. 8, lines 1-10); and

initiating a transfer of funds from the second account to the new account, wherein the new account and the second account have a common account holder and wherein a third financial institution initiates the transfer of funds from the second account to the new account (fig. 2 and associated text; col. 7, lines 63-67; col. 8, lines 1-10).

Claim 57. Sullivan et al. discloses a method as recited in claim 56 wherein the transfer of funds from the second account to the new account utilizes an Automated Clearing House network (col. 10, lines 53-62; fig. 2 and associated text).

Claim 58. Sullivan et al. discloses a method as recited in claim 56 wherein the transfer of funds from the second account to the new account utilizes a payment processor (col. 10, lines 53-62; fig. 2 and associated text).

Claim 59. Sullivan et al. discloses a method as recited in claim 56 wherein the transfer of funds from the second account to the new account includes issuing a debit instruction associated with the second account that transfers funds to a third account associated with the third financial institution and issuing a credit instruction that transfers funds from the third account to the new account (col. 7, lines 63-67; fig. 4 and associated text).

Claim 60. Sullivan et al. discloses a method as recited in claim 56 wherein the new account is an asset account (col. 7, lines 63-68; col. 8; lines 1-14).

Claims 61 and 65: Sullivan et al. disclose a method and corresponding computer program comprising:

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transferring assets from a first account at a first financial institution to a second account at a second financial institution via a debit instruction , wherein the first account and the second account have different account holders (col. 7, lines 63-67; fig. 4 and associated text) ; and

transferring assets from the second account to a third account at a third financial institution via a credit instruction, wherein the second account and the third account have different account holders, and wherein the first account and the third account have a common account holder (col. 7, lines 63-67; fig. 4 and associated text).

Claim 62: Sullivan et al. disclose a method recited in claim 61 wherein transferring assets from the first account to the second account utilizes a first payment network and transferring assets from the second account to the third account utilizes a second payment network (figs. 3-4 and associated text).

Claim 63: Sullivan et al. disclose a method as recited in claim 61 wherein transferring assets from the first account to the second account utilizes a first payment network and transferring assets from the second account to the third account utilizes the first payment network (col. 10, lines 53-62; fig. 2 and associated text).

Claim 64: Sullivan et al. disclose a method as recited in claim 61 wherein transferring assets from the first account to the second account utilizes an Automated Clearing House (col. 10, lines 53-62; fig. 2 and associated text).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,664,727, USPN 6,058,378, USPN 6,226,623 B1 and USPN 6,374,231 B1 are cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Shih whose telephone number is 703-305-8550. The examiner can normally be reached on Flexible.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

sys



HANI M. KAZIMI
PRIMARY EXAMINER